

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Applicant: Kitsukawa)	Art Unit: 2611
Serial No.: 09/840,437)	Examiner: Srivastava
Filed: April 23, 2001)	50P4416
For: GATEWAY SCREEN FOR INTERACTIVE)	September 7, 2005
TELEVISION)	750 B STREET, Suite 3120
)	San Diego, CA 92101
)	

APPEAL BRIEF

Commissioner of Patents and Trademarks

Dear Sir:

This brief is submitted under 35 U.S.C. §134 and is in accordance with 37 C.F.R. Parts 1, 5, 10, 11, and 41, effective September 13, 2004 and published at 69 Fed. Reg. 155 (August 2004). This brief is further to Appellant's Notice of Appeal filed herewith.

Table of Contents

<u>Section</u>	<u>Title</u>	<u>Page</u>
(1)	Real Party in Interest.....	2
(2)	Related Appeals/Interferences.....	2
(3)	Status of Claims.....	2
(4)	Status of Amendments.....	2
(5)	Concise Explanation of Subject Matter in Each Independent Claim.	2
(6)	Grounds of Rejection to be Reviewed.....	3
(7)	Argument.....	4
App.A Appealed Claims		
App.B Evidence Appendix		09/08/2005 TL0111 00000028 09840437
App.C Related Proceedings Appendix		02 FC:1402 500.00 OP

11627.APP

CASE NO.: 50P4416
Serial No.: 09/840,437
September 7, 2005
Page 2

PATENT
Filed: April 23, 2001

(1) Real Party in Interest

The real party in interest is Sony Corp.

(2) Related Appeals/Interferences

An appeal has been filed in serial no. 09/834,511 that may tangentially be related to this appeal.

(3) Status of Claims

Claims 1-3 and 5-27 are pending. It is believed that Claim 2, which was amended to incorporate subject matter held to be allowable in Claim 4, stands allowed along with its dependent claims 3 and 5-8, although the advisory action failed to indicate claim status. Accordingly, Appellant believes that Claims 1 and 9-27 are finally rejected. Claim 4 has been canceled. Dependent Claims 11 and 19 have been indicated as reciting allowable subject matter.

(4) Status of Amendments

No amendments are outstanding.

(5) Concise Explanation of Subject Matter in Each Independent Claim, with Page and Figure Nos.

As an initial matter, it is noted that according to the Patent Office, the concise explanations under this section are for Board convenience, and do not supersede what the claims actually state, 69 Fed. Reg. 155 (August 2004), see page 49976. Accordingly, nothing in this Section should be construed as an estoppel that limits the actual claim language.

116A-7,APP

CASE NO.: 50P4416
Serial No.: 09/840,437
September 7, 2005
Page 3

PATENT
Filed: April 23, 2001

Claim 1 sets forth a gateway screen for an interactive television that includes a television content panel (100, figure 6, page 14, last paragraph) and an Internet content panel (102, id.) The gateway screen allows a consumer to simultaneously view television content and Internet content (page 13, last three lines). The gateway screen is displayed when the interactive television initially is turned on, and/or in response to the consumer toggling a gateway screen button (page 13, lines 4-6, figure 5, block 80).

Claim 9 recites an interactive television system that includes a Web server (14, figure 1, page 5, first full paragraph of detailed description), an interactive television system server (18, id. second paragraph), and a television signal source (28, figure 1, page 6, last paragraph). The system also includes an interactive television (22, figure 1, page 6, last paragraph) which receives information from the Web server, the interactive television system server, and the television signal source. The interactive television periodically displays a gateway screen with a television content region (supra) and an Internet content region (supra), with the gateway screen being automatically displayed upon energization of the television.

Claim 16 casts the invention as a method of interactive television that includes displaying a gateway screen in response to a user turning the television on, supra, and enabling a consumer to receive information from two or more of a Web server, an interactive television system server, and a television signal source via the gateway screen, supra.

(6) **Grounds of Rejection to be Reviewed on Appeal**

Claims 1, 9, 10, 12-18, and 20-27 have been rejected under 35 U.S.C. §103 as being unpatentable over Kikinis, USPN 5,929,849 in view of Hendricks et al., USPN 6,738,978, with some of these claims (12, 13, and 20) evidently also being rejected based on "official notice".

CASE NO.: 50P4416
Serial No.: 09/840,437
September 7, 2005
Page 4

PATENT
Filed: April 23, 2001

(7) Argument

As an initial matter, it is noted that according to the Patent Office, a new ground of rejection in an examiner's answer should be "rare", and should be levied only in response to such things as newly presented arguments by Applicant or to address a claim that the examiner previously failed to address, 69 Fed. Reg. 155 (August 2004), see, e.g., pages 49963 and 49980. Furthermore, a new ground of rejection must be approved by the Technology Center Director or designee and in any case must come accompanied with the initials of the conferees of the appeal conference, *id.*, page 49979.

It is admitted in the Office Action that the primary reference fails to teach the heart of the invention, i.e., the gateway screen. The examiner proposes adding to the primary reference the startup screen 1000/home menu 1010 of Hendricks et al. (since the rejection refers to col. 43, lines 37-44 which teach only of these menus), but the problem with this is that the proposed combination would not arrive at the claims. Specifically, the start up screen 1000 of Hendricks et al. shows only "important messages", col. 44, lines 39 and 40, while the home menu 1010 shows other menus (col. 44, lines 25-30 and Figure 26), not TV or Internet content. In contrast, the gateway screen of Claims 1 and 9 displays both TV and Internet content and the screen of Claim 16 permits selection of both Internet and TV content, not mere selection of other menus.

This short yet accurate analysis has essentially been left unrebutted. Instead of trying to explain why the proposed combination would arrive at the claims, the advisory action simply castigates Appellant for "attacking references individually". But how else is a patent applicant supposed to illustrate why a proposed combination would not arrive at his claims, other than by explaining deficiencies in individual references? The glaring omission of any attempt to rebut Appellant's point that the references even if properly combined

CASE NO.: 50P4416
Serial No.: 09/840,437
September 7, 2005
Page 5

PATENT
Filed: April 23, 2001

would not arrive at the claims is so salient as to amount to an admission that Appellant is correct. In fact, the advisory action fatally exposes the flaw in the examiner's case, by tacitly equating the "start up screen" of Hendricks to a claimed gateway screen which contains unmentioned elements, e.g., both a TV panel and an Internet panel, that are not contemplated by any reference, individually or taken as a whole. That is the flaw - the willing, studied ignorance of specifically claimed elements that are absent from the references as a whole. This is not engaging in "piecemeal analysis" but rather an evisceration of a poorly made *prima facie* case.

The examiner relies on Berstis et al., USPN 5,867,154 to support his previous taking of "official notice" of features in Claims 5, 6, 12, 13, and 20. However, no matter how an element is shown, whether by "official notice" or by prior art reference, the requirement remains that the prior art must supply the motivation to combine the element with the rest of the claimed elements. That is, regardless of how an element is identified in the prior art, i.e., using a reference or "official notice", the remaining task for an examiner is to show why the prior art suggests the element in the combination claimed. In the present case, the preferred suggestion to combine an Internet button with a remote - "for the benefit of direct connection to an Internet gateway screen" - comes from the present invention and not from Kikinis or Berstis et al., neither of which contemplate the claimed gateway screen.

Moreover, no mere "Internet button" is being claimed in Claims 5 and 6, but rather a specific "gateway screen" button which, when pressed, causes a gateway screen having both TV and Internet content to be displayed. The only thing Berstis et al. discloses about its "Web button" is that it allows browsing of the Internet, which could mean many unknowable things but which certainly does not imply the invocation of a screen that has both Internet and TV content.

1168-7.APP

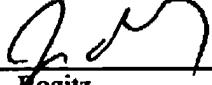
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(WED) SEP 7 2005 11:47/ST. 11:45/No. 6833031196 P 9

CASE NO.: 50P4416
Serial No.: 09/840,437
September 7, 2005
Page 6

PATENT
Filed: April 23, 2001

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1168-2.APP

CASE NO.: 50P4416
Serial No.: 09/840,437
September 7, 2005
Page 7

PATENT
Filed: April 23, 2001

APPENDIX A - APPEALED CLAIMS

1. A gateway screen for an interactive television, comprising:
at least one television content panel; and
at least one Internet content panel, the gateway screen allowing a consumer to simultaneously view television content and Internet content, the gateway screen being displayed when the interactive television initially is turned on, and/or in response to the consumer toggling a gateway screen button.
9. An interactive television system, comprising:
at least one Web server;
at least one interactive television system server;
at least one television signal source; and
at least one interactive television, the interactive television receiving information from the Web server, the interactive television system server, and the television signal source, the interactive television periodically displaying a gateway screen, the gateway screen having at least one television content region and at least one Internet content region, the gateway screen being automatically displayed upon energization of the television.
10. The interactive television system of Claim 9, wherein the gateway screen is displayed when the interactive television is turned on.
11. (previously presented) The interactive television system of Claim 9, wherein the gateway screen is displayed in response to receiving a signal to deenergize the interactive television.
12. The interactive television system of Claim 9, further comprising a gateway screen button and the gateway screen is displayed when the gateway screen button is toggled.
13. The interactive television system of Claim 9, further comprising a remote control unit, the remote control unit having a gateway screen button and the gateway screen is displayed when the gateway screen button is toggled.
14. The interactive television system of Claim 9, wherein the television content panel includes content from the at least one television signal source.
15. The interactive television system of Claim 9, wherein the internet content panel includes content from the at least one Web server.
16. A method of interactive television, comprising the acts of:
displaying a gateway screen in response to a user turning the television on; and

CASE NO.: 50P4416
Serial No.: 09/840,437
September 7, 2005
Page 8

PATENT
Filed: April 23, 2001

enabling a consumer to receive information from at least two of: at least one Web server, at least one interactive television system server, and at least one television signal source via the gateway screen.

17. The method of Claim 16, wherein the gateway screen includes at least one television content panel and at least one Internet content panel.

18. The method of Claim 16, wherein the gateway screen is displayed when the interactive television is turned on.

19. (previously presented) The method of Claim 16, wherein the gateway screen is displayed in response to receiving a signal to deenergize the interactive television.

20. The method of Claim 16, wherein the gateway screen is displayed when a gateway screen button is toggled.

21. The method of Claim 17, wherein the television content panel includes content from the at least one television signal source.

22. The method of Claim 17, wherein the internet content panel includes content from the at least one Web server.

23. The method of Claim 16, further comprising the acts of:
receiving consumer input via a conventional TV control device; and
establishing the gateway screen based at least in part on the consumer input.

24. The method of Claim 16, wherein the gateway screen is stored in a memory within an interactive television.

25. The gateway screen of Claim 1, wherein content in the Internet content panel is related to content in the television content panel.

26. The gateway screen of Claim 25, wherein content in the television content panel is received real-time from a broadcast.

27. The gateway screen of Claim 25, wherein content in the television content panel is received from a storage associated with the television.

FROM ROGITZ 619 338 8078

(WED) SEP 7 2005 11:48/ST. 11:45/No. 6833031196 P 12

CASE NO.: 50P4416
Serial No.: 09/840,437
September 7, 2005
Page 9

PATENT
Filed: April 23, 2001

APPENDIX B - EVIDENCE

None (this sheet made necessary by 69 Fed. Reg. 155 (August 2004), page 49978.)

1168-7.APP

FROM ROGITZ 619 338 8078

(WED) SEP 7 2005 11:48/ST. 11:45/No. 6833031196 P 13

CASE NO.: 50P4416
Serial No.: 09/840,437
September 7, 2005
Page 10

PATENT
Filed: April 23, 2001

APPENDIX C - RELATED PROCEEDINGS

None (this sheet made necessary by 69 Fed. Reg. 155 (August 2004), page 49978.)

1168-7.APP